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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,106	03/29/2000	Frank McKeon	HMV-038.02	7239

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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 08/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,106

Applicant(s)

MCKEON F ET AL

Examiner

Christopher H Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1,11,12 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2-7,9,13,16,18,19 and 23-30 is/are rejected.
- 7) ☒ Claim(s) 8,14,15,17,20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed 5/23/2003 (paper no. 19) is acknowledged and entered into the record. Accordingly, claims 23-30 are newly added.
2. Claims 1-22 are pending, claims 1,11,12, and 22 are withdrawn from further consideration as being drawn to a non-elected invention. Applicant is reminded to cancel all claims drawn to non-elected subject matter.
3. Therefore, claims 2-10, 13-21, and 23-30 are examined on the record.

Claim Rejections Maintained - 35 USC § 102

4. The rejection of claims 2-7, 9, 13 and now newly added claims 23, 25,27, and 29 under 35 USC 102 (b) is maintained for the reasons of record. Applicant argues that the p63 protein disclosed by Pujol *et al* is not the same as that claimed in the instant invention. Applicant provides sequence alignment data comparing the sequences of SEQ ID Nos.: 13-24 with that of the p63 taught by Pujol *et al*. Applicant's arguments have been carefully considered but are not found persuasive because the claims recite a p63 protein of which can encompass the p63 protein taught by Pujol *et al*. There are no limitation found in the claims that would preclude the p63 protein taught by Pujol *et al*. Furthermore, the method of detecting p63 taught by Pujol *et al* is identical to the claimed method because Pujol *et al* teaches a method of determining the presence of p63 in metastatic breast carcinoma by using a p63 specific antibody.

Claim Rejections Maintained - 35 USC § 103

5. The rejection of claims 2-7, 9,13, 16, 18-19 and now newly added claims 23, 25,27, and 29 under 35 USC 103(a) is maintained for the reasons of record. Applicant's arguments are substantially similar to those arguments made above in the 35 USC 102(b) rejection. See above paragraph 4 for rejection response.

New Arguments

Claim Rejections - 35 USC § 112, 1st paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24,26,28, and 30 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written description in this case only sets forth SEQ ID NOS: 13-24 and therefore the written description is not commensurate in scope with the claims which read on proteins having amino acids sequences that are 98% identical to that of SEQ ID NOS. 13-24.

The claims recite an "amino acid sequence at least 98% identical" to SEQ ID Nos: 13-24 as part of the invention. However, there does not appear to be an adequate written description in the specification as-filed of the essential structural feature,

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physical/chemical properties, known characteristics, or correlative function that provides for proper identification of an amino acid sequence having at least 98% identity to any one of SEQ ID Nos 13-24. The Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement make clear that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001, see especially page 1106 3rd column).

Applicant does not appear to have reduced to practice any amino acid sequence which is 98% identical to any one of SEQ ID Nos: 13-24. Neither has Applicant provided a sufficient written description of any structure that may be correlated with the desired function of SEQ ID Nos.: 13-24. Thus the genus of compounds encompassed by this term is extensive and the artisan would not be able to recognize that Applicant was in possession of the invention as now claimed. Consequently, Applicant was not in possession of the instant claimed invention. See Regents of the University of California v. Eli Lilly and Co. 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997). Adequate written description of genetic material "requires a precise definition, such as by structure, formula, chemical name, or physical properties,' not a mere wish or plan for obtaining

the claimed chemical invention." Id. 43 USPQ2d at 1404 (quoting Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606). The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter of the claim. Id. 43 USPQ2d at 1406. A description of what the genetic material does, rather than of what it is, does not suffice.

Id.

While it is noted that the instant claims are drawn to methods, the claims nevertheless require an adequate written description of the amino acid sequences which are 98% identical to SEQ ID Nos: 13-24 employed in the methods.

Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001. Applicant is invited to point to clear support or specific examples of the claimed invention in the specification as-filed.

Conclusion

7. Claims 8, 14, 15, 17, 20, 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 10 appears to be free of the prior art.

No claim is allowed. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Christopher Yaen
Art Unit 1642
August 6, 2003


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600